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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/885,970	06/21/2001	Bruce A. Fogelson	7272-80216	5291

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EXAMINER

JANVIER, JEAN D

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 06/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/885,970

Applicant(s)

FOGELSON, BRUCE A.

Examiner

Jean Janvier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-58 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Specification

Claim Status

Claims 1-58 are currently pending in the Application.

Claim Objections

Claims 4, 32, 28 and 50 are objected to because of the following informalities-

Concerning claims 4 and 32, although the advertiser may **indicate whether the advertisement shall be printed in a physical ad-book**, however, as per the specification, **where advertisement may be viewed from user terminals 2, 4, ad-books may not be printed in physical form.** In other words, even if advertiser may indicate that his ads may be printed in a physical ad-book, the system is operable, however, to disable this function, especially since the advertisements are primarily viewed online or over the Internet. Thus, this indication is not necessary or useful since it cannot be enforced even if the advertiser wanted to have the advertisement printed in a physical ad-book and since the ad-book cannot be printed in a physical form (see paragraph [0036] and lines 13 and 14 of the specification).

Concerning claims 28 and 50, in the preamble sections, “such” should apparently be replaced with - the--.

Appropriate corrections are required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-9, 12-15, 16-27, 28-37, 40-49 and 50-58 are rejected under 35 U.S.C. 102(e) as being anticipated by Rothstein, US PUB, 2002/0188532A1.

As per claims 1-9, 12-15, 16-27, 28-37, 40-49 and 50-58, Rothstein discloses an apparatus and method for advertising in electronic documents (ad books). According to one implementation, the method includes receiving an electronic book from a publisher, receiving

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one or more electronic ads from one advertiser, inserting the electronic ads into the electronic book to create an enhanced electronic book (ad book) and sending the enhanced electronic book to a customer for viewing or reading the advertisements included in the ad book (See abstract; figs. 1-5; paragraph [0006]).

In general, publishers have begun to provide more substantial electronic documents, which are referred to herein as "electronic books." An example of an electronic book is a book that has been converted to electronic form for download and display. Electronic books have been developed for PDAs such as the Palm-Pilot and Windows CE devices. One supplier of such books is Peanut Press (www.peanutpress.com). See paragraphs [0004] and [0002], [0003] and [0005].

Rothstein discloses, in one embodiment, that the electronic ads are received from one or more advertisers over a network. When an enhanced electronic ad book, containing electronic ads associated with one advertiser, is sent to a customer via a hyperlink, a debit entry is created in the advertiser's account. Subsequently, the advertiser is billed according to the entries in the advertiser's account (charging the advertiser's a fee for inserting the ads in the ad book and for providing the ads via the ad book to the customer (providing the ad book to the user). See paragraphs [0008], [0007] and [0009].

Rothstein further discloses, in another aspect, that the location within the electronic book (ad book) for insertion of an ad is determined according to one or more keywords associated with the electronic ad. The keywords can be supplied by the **advertiser that** provided the ad. Pages within the electronic book can be scored according to the keywords and a suitable location is

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selected according to the score. Further, the electronic ads are inserted within a structured electronic document, such as a sound file or video file. See paragraphs [0010]-[0013].

Please consider the entire disclosure.

Claims 1-9, 12-15, 16-27, 28-37, 40-49 and 50-58 are rejected under 35 U.S.C. 102(e) as being anticipated by Mason, USP 6, 401,075.

As per claims 1-9, 12-15, 16-27, 28-37, 40-49 and 50-58, Mason discloses a method of and a system for receiving Internet-type advertisements from a plurality of advertisers, modifying the received advertisements to fit designated advertising spaces allotted by a plurality of different and unrelated online newspaper websites (processing by a server advertisements received from advertisers, modifying or converting the received and processed advertisements into a format or “ad book” format suitable to be inserted into a newspaper web site (classified ad type)) and automatically placing those advertisements into the newspaper web site for display. Preferred embodiments permit online advertisements to be tracked, audited and/or modified, at any time during an advertising campaign (fig. 1; col. 2: 6-61; col. 3: 1-42; col. 5: 4-32; col. 5: 33 to col. 6: 26).

Please consider the entire disclosure.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10-11 and 38-39 are rejected under 35 USC 103 (a) as being unpatentable over Rothstein, US PUB 2002/0188532.

As per claims 10-11 and 38-39, although Rothstein silently or implicitly supports at least the use of login names and passwords by at least the publishers and the advertisers to upload electronic books and advertisements data respectively onto the web server 220 of fig. 2, however, Rothstein does not explicitly disclose that the web server comprises **a firewall for maintaining security**.

However, it is common practice in the art of computer technology to use or install a firewall module (software) on a file server or local terminal to prevent unauthorized users from accessing the server or terminal, thereby securing or protecting data stored on the server or terminal.

“Official Notice”.

Therefore, an ordinary skilled artisan, using or implementing the system of Rothstein, would have been motivated at the time of the invention to incorporate the above disclosure

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("Official Notice") into the system of Rothstein so as to install a firewall module on the web server 220 to thereby protect the data, such as advertisement data and electronic book data, stored on the server by preventing unauthorized users from accessing the server, while providing a greater layer of security at the server side, as would have understood an ordinary skilled artisan.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US PUB 2002/0162106 to Pickover discloses a system for choosing an advertisement based on the last media content monitored just before the break. Alternatively, the content of various past selections may be monitored and acted upon in selecting advertising content. In yet another embodiment the system may be proactive and accept input from the client. For example, if the user selects the "change channel" button on a remote TV control, the TV may ask, "Would you like to hear an ad on cars?" or "Press 1 for an ad on cars; press 2 for an ad on books." Each of the above choices would be facilitated by an intelligent agent as being part of the system. In the absence of any other guidance, with or without the involvement of an intelligent agent, the advertisement to be presented may be determined by the queuing sequence of advertisements in the storage element (See abstract and [0010]).

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Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (571) 272-6719. The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (571) 272- 6724.

Non-Official- 571-273-6719.

Official Draft : 571-273-8300

06/24/06

JDJ

Jean D. Janvier

Patent Examiner

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**JEAN D. JANVIER
PRIMARY EXAMINER**

